In the Supreme Court of the United States.

OCTOBER TERM, 1903.

No. 13. ORIGINAL.

EX PARTE HERMAN FRASCH, PETITIONER.

ON PETITION FOR WRIT OF MANDAMUS TO THE COURT OF APPEALS, DISTRICT OF COLUMBIA.

BRIEF FOR RESPONDENTS.

This is an original petition for mandamus to be directed to the chief justice and associate justices of the court of appeals, District of Columbia, commanding them to hear on its merits and determine petitioner's appeal to that court from a decision of the Commissioner of Patents.

The proceedings in the Patent Office began with an application by Herman Frasch, filed November 13, 1899, for a patent covering a process and apparatus for removing incrustations of calcium sulphate from brine-heating surfaces.

The application contained six claims, the first three of which were for the process and the last three for a particular apparatus to be used in applying the process.

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On December 16, 1899, the Commissioner notified the applicant that the primary examiner had ruled that his specifications and claims presented two different subjects of invention—process and apparatus—called his attention to Rule 41, requiring division in such cases, and stated that "division on this line must be made before action upon the merits can be given."

Rule 41 is as follows:

> Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.
>
> Claims for a machine and its product must be presented in separate applications.
>
> Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.
>
> Claims for a process and its product may be presented in the same application.

Upon further consideration, and after hearing argument, the examiner repeated the order for division, and the applicant was notified that there was no appeal because there had been no rejection of his application; and the examiner, though requested so to do, therefore declined to transmit the case to the examiners in chief on appeal from his decision, but advised applicant of his right to petition the Commissioner under Rule 145, which is as follows:

Rule 145. Upon receiving a petition stating concisely and clearly any proper question which has been twice acted upon by the examiner, and which does not involve the merits of the invention claimed, or the rejection of a claim, and also stating the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the Commissioner, and directing the examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within *five days after being notified of the order fixing* the day of hearing. The examiner shall at the time of making such statement furnish a copy thereof to the petitioner. No fee is required for such a petition.

On December 19, 1901, applicant presented a petition to the Commissioner, in which he recited the proceedings in the office, the rulings of the examiner, and prayed relief; and on January 23 thereafter the following decision upon the same was rendered:

> This is a petition from the action of the primary examiner, requiring division in the above-entitled case and refusing to forward to the examiners in chief an appeal which has been filed.
>
> The application includes claims to a process and claims to an apparatus, and therefore the examiner properly required division, and refused to act upon the merits of the claims until that requirement was complied

with. The petitioner regarded this as a refusal of a patent to him and filed a request for reconsideration, which he calls a persistence in his claim, under section 4903 of the Revised Statutes, and upon a repetition of the requirement for division filed an appeal to the examiners in chief.

A requirement for division is not an action upon the merits of the application, but is a mere matter of form, and therefore a party has no right to appeal to the examiners in chief from such a requirement. It is not a refusal of a patent or patents upon the alleged invention or inventions, but is a ruling that the application therefor has not been made in proper form. The requirement of division may be and often is made where all of the claims are admitted to be patentable. The objection is to the way in which the matter is presented and not to the matter itself. The examiner was right in refusing to forward the appeal.

The petition is denied. (Record, 30–31.)

From the decision of the Commissioner an appeal was prosecuted to the court of appeals for the District of Columbia, where petitioner contended that rule 41 is inconsistent with the statutes providing for the grant of letters patent beyond the power of the Commissioner of Patents to enact, and that in this case the rule had worked a practical denial of his application; and, further, that the Commissioner erred in sustaining the examiner and refusing to direct that an appeal be granted to the board of examiners in chief.

The Commissioner appeared and moved to dismiss the appeal for want of jurisdiction to entertain the same. The cause was heard and, after consideration thereof, the motion was granted and the appeal dismissed, the court being of the opinion that the merits of the original application had not been considered or passed on, that the order of the primary examiner was a mere interlocutory one, and that no final decision on the merits had been rendered. The opinion of the court, an elaborate one, is found in the record.

After decree dismissing the appeal was directed, petitioner asked the court to reinstate the case and to hear and determine the same, supporting this motion with an elaborate argument. Upon consideration this was denied.

At the October term, 1903, an original application was presented to this court, asking leave to file a petition for mandamus to the chief justice and associate justices, court of appeals, District of Columbia, commanding them to hear and determine upon the merits the appeal from the decision of the Commissioner of Patents. Permission having been granted, the petition was filed here and a rule issued requiring said chief justice and associate justices to show cause why the writ of mandamus should not issue as prayed for.

Answer has been made to the rule, from which it appears that the court of appeals considered the appeal to it from the Commissioner, and being of the opinion that the ruling made by him was

merely upon a question of procedure, and not a rejection of a claim or the refusal of a patent from which an appeal is permitted under the provisions of section 4911 of the Revised Statutes, they therefore dismissed the same.

Code of the District of Columbia, act of March 3, 1901 (31 Stats., 1227):

> SEC. 233. Any final judgment or decree of the court of appeals may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in all cases in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars, * * * and also in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright, or in which is drawn in question the validity of a treaty or statute of, or an authority exercised under, the United States.
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> SEC. 234. In any case heretofore made final in the court of appeals it shall be competent for the Supreme Court of the United States to require, by certiorari or otherwise, any such case to be certified to said Supreme Court for its review and determination. * * *

Petitioner now asks that the writ of mandamus issue as originally prayed for, notwithstanding the return of the justices of the court of appeals of the District of Columbia.

The return to the rule shows the court of appeals of the District of Columbia both heard and determined the cause which was submitted to them, and upon full consideration were of opinion that the statutes had not given them jurisdiction in such a case to review and revise the action of the Commissioner, and it was so adjudged. This was a final adjudication of the matter before them. This court is now asked to interpose, by writ of mandamus, to reverse the ruling of the lower court as to jurisdiction, and to command it to adjudge the issues upon other considerations.

If petitioner is entitled to have the action of the court of appeals reviewed in this court, he should have asked for a writ of certiorari.

The section of the District Code above quoted gives this court the right to review any final judgment of the court of appeals, when no appeal or writ of error has been given, by writ of certiorari, and if petitioner is entitled to have the opinion now complained of reviewed here, he should have applied for such a writ. The law is well settled that mandamus will not be granted where there is another adequate remedy.

Ex parte Newman, 14 Wall., 152.
In re Grossmeyer, 177 U. S., 49.
In re Key, 189 U. S., 84.

In *Mutual Life Ins. Co.* v. *Finney* (178 U. S., 327), the case was taken on error to the circuit court of

appeals, which court dismissed the writ on the ground that it had no jurisdiction. Application was made to this court and the case brought here on certiorari, where the issues involved were considered and the case remanded.

An express remedy is afforded by statute—plain, specific, and fully adequate to redress any grievance complained of by petitioner.

Petitioner's whole case is based upon the contention that the Commissioner in person has definitely rejected the application and refused the patent applied for, and that such decision is not interlocutory but final.

The statutes provide where an application for a patent has been twice rejected by the primary examiner an appeal may be taken to the board of examiners in chief, and from that board a further appeal is given to the Commissioner in person; and finally, from the decision of the Commissioner an appeal may be taken to the court of appeals of the District of Columbia, which court is required to hear and determine the appeal and revise the decision in a summary way. (Rev. Stat., sections 4909–10–11, 4914; act creating court of appeals, D. C., Feb. 9, 1893, sec. 9.)

Section 4915, Revised Statutes, provides: "Whenever a patent on application is refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia, upon

appeal from the Commissioner the applicant may have a remedy by bill in equity, and the court * * * may adjudge that such applicant is entitled, according to law, to receive a patent for his invention as specified in his claim, or for any part thereof, as the facts of the case may appear * * *."

If, as petitioner maintains, the judgment of the Commissioner denying his request was final and a definite rejection of his application for a patent, the statute above referred to gives him a plain and adequate remedy, and it is well established that under such circumstances mandamus will not lie.

High's Extraordinary Legal Remedies, section 16: "Whenever, therefore, an express remedy is afforded by statute, plain and specific in its nature, and fully adequate to redress the grievance complained of, mandamus will not lie."

In *Morgan* v. *Daniels* (153 U. S., 124), it was said by this court that a bill in equity filed under section 4915, Revised Statutes, "is something more than a mere appeal. It is an application to the court to set aside the action of one of the Executive Departments of the Government."

In *Butterworth* v. *Hoe* (112 U. S., 68), this court held that the remedy by a bill in equity under section 4915, Revised Statutes, applies "when the Commissioner decides to reject an application for a patent on the ground that the applicant is not on the merits entitled to it."

A mandamus can never be used to perform the office of a writ of error or appeal, and whether it shall issue in any case is a matter of discretion.

In *Ex parte Newman* (14 Wall., 152) there came before this court an application for a writ of mandamus directed to the judge of the United States circuit court. A libel had been filed in the district court, and from its action in reference thereto an appeal was taken to the circuit court, where it was dismissed for want of jurisdiction. Thereupon this court was asked to issue a mandamus to the circuit judge, commanding him "to entertain jurisdiction of said cause on appeal and to hear and decide the same on the merits," and the request was refused. The question involved was elaborately considered, and Justice Clifford, who delivered the unanimous opinion of the court, among other things (p. 165), said:

> Applications for a mandamus to a subordinate court are warranted by the principles and usages of law in cases where the subordinate court, having jurisdiction of a case, refuses to hear and decide the controversy, or where such a court, having heard the cause, refuses to render judgment or enter a decree in the case; but the principles and usages of law do not warrant the use of the writ to reexamine a judgment or decree of a subordinate court in any case, nor will the writ be issued to direct what judgment or decree such a court shall render in any pending case, nor will the writ be issued

in any case if the party aggrieved may have a remedy by writ of error or appeal, as the only office of the writ when issued to a subordinate court is to direct the performance of a ministerial act or to command the court to act in a case where the court has jurisdiction and refuses to act, but the supervisory court will never prescribe what the decision of the subordinate court shall be, nor will the supervisory court interfere in any way to control the judgment or discretion of the subordinate court in disposing of the controversy. * * * (P. 168.) Confessedly, the petitioners are without remedy by appeal or writ of error, * * * and it is insisted that they ought on that account to have the remedy sought by their petition. Mandamus will not lie, it is true, where the party may have an appeal or writ of error, but it is equally true that it will not lie in many other cases where the party is without remedy by appeal or writ of error. * * * The writ of mandamus will not lie in any case to a subordinate court unless it appears that the court of which complaint is made refused to act in respect to a matter within the jurisdiction of the court, and where it is the duty of the court to act in the premises. * * * Superior tribunals may by mandamus command an inferior court to perform a legal duty where there is no other remedy, and the rule applies to judicial as well as to ministerial acts, but it does not apply at all to a judicial act to correct an error, as where the act has been erroneously

> performed. If the duty is unperformed and it be judicial in its character, the mandate will be to the judge directing him to exercise his judicial discretion or judgment, without any direction as to the manner in which it shall be done, or if it be ministerial, the mandamus will direct the specific act to be performed.

In *Ex parte Railway Company* (103 U. S., 794) this court decided that it would not issue a mandamus to a circuit court directing it to restore to the docket a cause which had been dismissed upon a plea to the jurisdiction. In denying the motion to show cause why a peremptory mandamus should not issue, Mr. Chief Justice Waite (p. 796) said:

> This motion is denied, first—because it is an attempt to use the writ of mandamus as a writ of error to bring here for review the judgment of the circuit court upon a plea to the jurisdiction filed in the suit. * * *

In *Ex parte Baltimore and Ohio Railroad* (108 U. S., 566) the court denied a petition for mandamus to the circuit court of the United States directing it to take jurisdiction in a replevin suit, wherein the writ had been quashed and vacated. Mr. Chief Justice Waite, delivering the opinion of the court (p. 567), said:

> This is a final judgment in the action, and, if the case is otherwise within our jurisdiction, subject to review here on a writ of error. Upon such a writ the question of the right to maintain the action on which the cause was adjudged below, if presented

> by the record, may be reexamined here. It has been often held that mandamus can not be used to perform the office of a writ of error.

In *American Construction Company* v. *Jacksonville Company* (148 U. S., 372), wherein a petition was filed asking for a mandamus, Mr. Justice Gray, speaking for the court (p. 379), said:

> A writ of mandamus can not be used to perform the office of an appeal or writ of error to review the judicial action of an inferior court. * * * It does not, therefore, lie to review a final judgment or decree of the circuit court sustaining a plea to the jurisdiction, even if no appeal or writ of error is given by law.

In the recent case of *In re Key* (189 U. S., 84) application was made to this court for leave to file a petition for mandamus requiring the court of appeals for the District of Columbia to reinstate, and proceed to a hearing and determination on the merits, an appeal to it from the supreme court of the District, which, upon motion, had been dismissed upon the ground that it had no jurisdiction on appeal from the judgment of the court below in such cases. In an opinion denying the writ, Mr. Chief Justice Fuller, speaking for the court (p. 85), said:

> The writ of mandamus can not be used to perform the office of an appeal or writ of error and does not lie to review a final judgment or decree sustaining a plea to the jurisdiction even if no appeal or writ of error

> is given by law. It is not granted in doubtful cases, or where there is another adequate remedy, and whether it shall go or not usually rests in the sound discretion of the court.

High's Extraordinary Legal Remedies, section 191:

> It may be said generally that when a court, acting in a judicial capacity, has dismissed an appeal from an inferior tribunal its order of dismissal is regarded as a judicial determination of the question, and however erroneous, it is final and conclusive, and its correctness will not be questioned by mandamus. Thus, when a court of general jurisdiction has dismissed an appeal from a justice of the peace, mandamus will not lie to compel it to proceed to a hearing and determination of the appeal, since the effect of the writ in such case would be to review all the proceedings of the court below and to convert the writ of mandamus into a writ of error.

The decision of the court of appeals in dismissing the appeal from the Commissioner of Patents was correct.

The right of an appeal from the action of the Commissioner to the court of appeals of the District of Columbia is based on the provisions of sections 4909, 4910, and 4911 of the Revised Statutes, the act of February 9, 1893 (ch. 74), enti-

tled "An act to establish a court of appeals for the District of Columbia, and for other purposes," and section 228 of the Code of the District of Columbia (c. 854, act of 1901). The acts of 1893 and 1901 confer upon the court of appeals the jurisdiction formerly granted to the supreme court of the District of Columbia by the three sections of the Revised Statutes just referred to, which are as follows:

> SEC. 4909. Every applicant for a patent or for the reissue of a patent any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief, having once paid the fee for such appeal.
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> SEC. 4910. If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person.
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> SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the supreme court of the district of Columbia, sitting in banc.

The right of appeal given by section 4911, Revised Statutes, exists only where there has been an adverse decision upon the merits, and in the present case no such decision was made by the Commissioner.

It is clear that the Commissioner's decision, to be appealable under section 4911, Revised Statutes, must amount to a final rejection of the application and must dispose of the whole case on its merits, and not merely relate to a preliminary question of procedure.

Bostwick v. *Brinkerhoff* (106 U. S., 3):

> If the judgment is not one which disposes of the whole case on its merits, it is not final. Consequently it has been uniformly held that a judgment of reversal with leave for further proceedings in the court below can not be brought here on writ of error.

This court, in *Butterworth* v. *Hoe* (112 U. S., 50), held in effect that the ruling of the Commissioner, to be appealable, must be adverse upon the merits of the claim, for it was there said in reference to the statute and the companion statute (section 4915) relating to a bill in equity:

> It applies only when the Commissioner decides to reject an application for a patent on the ground that the applicant is not, on the merits, entitled to it.

In that case the Commissioner refused to issue the patent, but made no ruling upon the merits, and this court accordingly held the remedy was not by appeal or bill in equity.

In *Commissioner of Patents* v. *Whiteley* (4 Wall., 522), cited by the petitioner, the Commissioner ruled adversely upon the merits of the applicant's claim, holding that he was not the owner of the

invention and was not entitled to a reissue and that if granted to him upon that application or any other, it would be invalid. The ruling disposed of the whole case on its merits and supports the view that the decision must go to the merits before an appeal will lie. It was not the purpose of section 4911 to give the court of appeals power to regulate mere matters of procedure as they arise in patent applications, since section 483, Revised Statutes, expressly gives to the Commissioner of Patents authority to make rules governing procedure. The statutes unmistakably point to him and not to the court as the one to govern such questions. The court merely reviews and directs upon the merits of cases.

The court of appeals said in *Steinmetz* v. *Allen* (104 O. G., 853):

> It is not denied that to constitute a rejection of the claims in the meaning of the statute the action * * * must amount in legal effect to an adverse decision in respect to the merits of the claim and be of a character to defeat the right to the patent therefor, unless reversed on appeal.

This has been the uniform construction of the law by all tribunals that have considered it, and it is clearly the right one.

The ruling by the Commissioner in the present case did not reach the merits. There is no holding that the petitioner is not entitled to every claim

made by him. He has not been required to relinquish any of his claims, but has merely been required to present them separately instead of together. This is clearly a matter of procedure, and it alone would have been settled by the court of appeals if the appeal had not been dismissed. A decision of the question presented would not have determined whether the applicant was to receive a patent upon any claim made by him. That would have remained to be determined when the merits of the claims were considered. The question was, therefore, clearly a preliminary one relating to procedure and not an appealable question disposing of the whole case upon the merits.

Division is not required upon the ground that the patent, if granted covering the two inventions, would be declared invalid. No question as to the validity of the patent is involved, since the courts have never declared a patent invalid because of the joinder of distinct inventions. Division, therefore, involves no question of merits.

Commissioner Fisher said as far back as 1869, referring to decisions sustaining patents:

> The doctrine of both of these cases seems to be that while the rule which assigns distinct inventions to distinct patents is a proper one, and one which the Com nissioner may properly enforce, yet, if the patent actually issue, the courts will sustain it. It is certainly nowhere asserted that it is the duty

> of the Commissioner to include two or more inventions in one patent, but it is evidently referred to his discretion. (*Ex parte Yale*, C. D., 1869, 110.)

At about the same time this court said in *Bennett* v. *Fowler* (8 Wall., 445):

> It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvements shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the Patent Office. It is often a nice and perplexing question.

In *Ex parte Mefford* (C. D., 1883, 95; 25 O. G., 1881), Commissioner Butterworth said:

> From the decisions of the courts prior to this time it is clear that a patent containing them all would not for that reason be held invalid. (*Hogg* v. *Emerson*, 6 Howard, 437; *Barrett* v. *Hall*, 1 Mason, C. C., 447; *Moody* v. *Fisk*, 2 Mason, 112; *Wyeth* v. *Stone*, 1 Story, 273.)
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> But it does not follow because the courts would not hold the patent invalid that it is the duty of the Patent Office to allow the application in its present form.

These cases announce the construction of the law which has always been followed. *Ex parte Fefel*, 57 O. G., 409; *ex parte Everson*, 68 O. G., 1381; *ex parte Burgess*, 64 O. G., 1759; *ex parte Demeny*, 64 O. G., 1649.

The reason for requiring division was thus stated by Commissioner Fisher in *ex parte Yale* (*supra*):

> Another consideration, which is not less important, is found in the classification of the various subjects of invention and the assignment of the different classes to different examiners. This division of labor is absolutely essential to the prompt and thorough examination of applications. It is adopted to facilitate the transaction of the public business, and the inventor himself is directly and immediately benefited by a strict adherence to it. Any union of inventions in one patent that would seriously impair this classification ought not to be permitted. Besides the delay and increased difficulty in making the examination, if the patent covers devices which enter into two classes, the drawing, which is single, must be deposited in the portfolio of the one class and be wanting in the portfolio of the other. It may thus be overlooked in the examination of the next case.

In *Ex Parte Everson* (*supra*), twenty-four years later, it was said:

> The office classification must be considered in determining the question whether process and apparatus may be joined in the same application. This question of classification is one of the highest importance, and unless the lines of classification are kept clear there is danger that the present patent system will fall to pieces of its own weight.

It is absolutely necessary that the question of division be controlled by the Commissioner under his authority as an executive officer in order that he may carry out the examination system which Congress has created. The problem of classification is a serious one when it is considered that 25,000 patents are granted each year.

The requirement for division merely affects the question of costs to the applicant and does not affect substantial rights. The question of costs is not appealable.

The petitioner argues that if his process and his apparatus claims are embodied in two patents instead of one, the courts may hold one of those patents invalid. There is no suggestion that *both* patents will be declared invalid, but merely that *one* may be. The only possible ground, and the only one suggested why one patent may be declared invalid, is that it covers the same thing as the other. Two patents for the same thing are not permissible.

If they do cover the same thing and one is sustained the applicant has all necessary protection. He is not entitled to duplicate claims in one patent any more than in two.

As a matter of fact, however, there is no danger whatever of the court holding that a patent upon a process covers the same thing as a patent upon the apparatus. If the process claim is not independent of the apparatus, it is merely for the function of

the apparatus and is invalid, whether in the same case or a separate case. This is settled by many decisions of this court.

It is a well-settled principle in patent law that a process and an apparatus are distinct, separable, and independent things. A process is the mode of treatment to produce a certain result, and as said in *Cochrane* v. *Deemer* (94 U. S., 780):

> It is an act or a series of acts performed upon the subject-matter to be transformed and reduced to a different state or thing—

whereas a machine is a combination of mechanical elements which may or may not be useful in performing the acts which constitute the process.

As was said in *Corning* v. *Burden* (15 How., 252):

> It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not affected by mechanism or mechanical combinations.

The court in that case further pointed out that an alleged process which is the mere function of mechanism is not patentable.

As said in *James* v. *Campbell* (104 U. S., 356):

> A patent for a process and a patent for an implement or a machine are very different things.

In *Heald* v. *Rice* (104 U. S., 737) this court said:

> A patent for a machine can not be reissued for the purpose of claiming the process of operating that class of machines, because,

> if the claim for the process is anything more than for the use of the particular machine patented, it is for a different invention.

If it is for the mere use of the machine it is not patentable, because not a true process.

In *Tilghman* v. *Proctor et al.* (102 U. S., 707), it was said:

> It is very certain that the means need not be a machine or an apparatus. It may, as the court says, be a process. A machine is a thing. A process is an act or a mode of acting. The one is visible to the eye—an object of perpetual observation. The other is a conception of the mind, seen only by its effects when being executed or performed. Either may be the means of producing a useful result.

In *Rubber Company* v. *Goodyear* (9 Wall., 788–796), Mr. Justice Swayne, delivering the opinion, said:

> Patentable subjects, as defined by the patent law, are "any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter." A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable. Both may be new or both may be old. In the former case both would be

> patentable; in the latter, neither. The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability or the issuing of a patent as to one in no wise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts. Such is the sound and necessary construction of the statute.

If the appellant succeeds in obtaining a decision that his process is absolutely dependent upon his mechanism, he will then have a decision that his process claims are not patentable because for the function of his mechanism.

An examination of the published decisions of the Patent Office (which extend from 1869 to date) fails to reveal any case in which the question of division has been treated as an appealable matter under sections 4909, 4910, and 4911, Revised Statutes. It has uniformly been held that it was a preliminary matter left entirely to the discretion of the Commissioner of Patents.

Present rule 42 of the Patent Office provides that where a party is required to divide his application and limit it to one invention—

> If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise it may be made at any time before final action thereon.

There have been differences of opinion as to when division should be required, some holding that division should always be required between process and apparatus (*Ex parte Blythe*, 30 O. G., 1321, C. D., 1885, 82; *Ex parte Herr*, 41 O. G., 463, C. D., 1887, 105; *Ex parte Boucher*, 88 O. G., 545, and *Ex parte Frasch*, 91 O. G., 459), and others holding that the question depended upon the circumstances of the particular case. There has never been a difference of opinion, however, upon the question whether division affects the merits and is an appealable matter.

This uniform and long-established construction of the statute by the able patent lawyers who have held the position of Commissioner is entitled to great weight. As said in *Bate Refrigerating Company* v. *Sulzberger* (157 U. S., 1):

> If the statute be not so explicit as to preclude construction; if upon applying to it the established rules of interpretation; if looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting either one of two constructions; this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the Government.

To adopt the construction contended for by this petitioner would be to upset the entire practice of the Patent Office, under which 50,000 applications

for patents are disposed of each year. To hold that preliminary matters are appealable would cause great confusion.

If one ruling as to procedure is appealable, all others are. Last year the Commissioner decided 1,814 cases on interlocutory petition without fee, and 118 cases on appeal under section 4910, Revised Statutes. If rulings as to procedure are appealable, each of those cases should have come before him by appeal. The appeal fees alone would have amounted to $54,420. The present case came before him by interlocutory petition without fee and not by appeal.

The court of appeals well said, in *Steinmetz* v. *Allen* (*supra*):

> These rules, with many others, forming a system of practical procedure for the Patent Office, were adopted by able and experienced patent lawyers who occupied the position of Commissioner of Patents, and they have been in force for many years and the practice of the office has been made to conform to them. To support, at this late day, the contention of the appellant and declare these rules in any material respect invalid upon the theory that they restrict the right of appeal, would be attended with very serious consequences to the Patent Office, indeed to the public. An established practice, such as has obtained under these

rules, ought not to be disturbed by the court, except upon the clearest principle of right and necessity.

RESPONDENTS RESPECTFULLY ASK THAT THE PETITION FOR MANDAMUS BE DISMISSED.

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Of Counsel.

WASHINGTON, *December, 1903.*

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Office Supreme Court U.S.
FILED
OCT 16 1903
JAMES H. McKENNEY,
Clerk.

Supreme Court of the United States.

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To the Honorable the Justices of the Supreme Court of the United States:

The answer of the Chief Justice and the Associate Justices of the Court of Appeals of the District of Columbia to the rule issued herein upon them to show cause why a writ of mandamus should not issue, commanding them to hear and determine an appeal taken by the petitioner from a decision of the Commissioner of Patents.

The said Chief Justice and Associate Justices of the Court of Appeals of the District of Columbia respectfully answer and certify to the honorable Supreme Court—

(1) That they suppose that the petitioner has correctly set forth the matters appearing of record in the proceedings in his application in the Patent Office, in so far as he undertakes to relate them, but for greater certainty they refer to the copy of the record filed with the petition for accurate information as to the matters and things therein recorded.

(2) That the petitioner took an appeal to the Court of Appeals of the District of Columbia from a ruling by the Commissioner of Patents in the matter of his application for a patent, and the respondents after hearing the cause and upon consideration of a motion to dismiss made by the Commissioner of Patents dismissed the appeal for lack of jurisdiction, since in their opinion the ruling of the Commissioner of Patents was not an appealable decision. The ruling of the Commissioner was a requirement that the applicant divide his application and present his claims to the process and his claims to the apparatus in separate applications, as required in Rule 41 of the Rules of Practice of the Patent Office, instead of joining them in one application. This ruling was made by the Commissioner of Patents upon an interlocutory petition to him under Rule 145 of the Rules of Practice of the Patent Office from the action of the primary examiner requiring the application to be divided and limited to one invention before giving action upon the merits of the application. It was not a final

decision made by him on an appeal, under section 4910 of the Revised Statutes. It was a preliminary ruling upon a question of procedure and was not a rejection of a claim or the refusal of a patent. There had been no consideration of or action upon the merits of the application. Upon consideration of the appeal, the respondents were called upon to decide whether or not the rulings of the Commissioner upon such preliminary questions of procedure were appealable to the Court of Appeals of the District of Columbia, and it was and is their judgment that such rulings are not appealable, and for that reason they dismissed the petitioner's appeal, as will more fully appear from their opinion rendered, a copy of which is attached to the petition herein.

Wherefore these respondents having fully answered, pray to be hence dismissed.

R. H. ALVEY,
Ch. Justice.
M. F. MORRIS.
SETH SHEPARD.

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